

NEIFELD DOCKET NO: OBSP5GARD-USC2

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF: WILL GARDENSWARTZ

SERIAL NO: 09/893,775

USPTO CONFIRMATION CODE: 5962

FILED: 6/29/2001

EXAMINER: Donald Champagne

GROUP ART UNIT: 3622

FOR: Communicating with a Computer Based on the Offline Purchase History of a Particular Consumer

ASSISTANT COMMISSIONER FOR PATENTS

ALEXANDRIA, VA 22313

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37 CFR 41.52 REQUEST FOR RECONSIDERATION

Date: 1-3-2009

/RichardNeifeld#35,299/

RICHARD NEIFELD, REG. NO. 35,299

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37 CFR 41.52 REQUEST FOR REHEARING

Sir:

In response to the decision on appeal, consider these remarks.

Respectfully Submitted,

1-3-2009

DATE

/RichardNeifeld#35,299/

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Attorney of Record

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Decision pages 11 and 12 rejects the examiner's rationale for supporting rejection and substitutes a new rationale, stating that:

We are not convinced that even if the portable in Biorge were not used to effect an offline purchase, that the purchase would be tracked by a system enough to match a related advertisement to the user based on that purchase. However, we do not consider this ambiguity to be error in the prima facie case made under 35 U.S.C. 5 103(a) because Stein offers a clearer teaching on this point.

Stein discloses the use of a host computer which tracks purchase history of a consumer on a national basis at brick and mortar stores (e.g., off line purchases) and updates a database so that the database is current at whatever store the consumer purchases (FF 2). To use a computer, such as host computer 13 in Stein, in conjunction with the first computer or portable device in Biorge to create a centralized database which accounts for offline purchases and causes the involved consumer to receive updated advertisements or coupons (FF 3,4) based on all purchases would be a predictable variation to the Biorge system. "When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or in a different one. If a person of ordinary skill can implement a predictable variation, 5 103 likely bars its patentability." KSR, 127 S. Ct. at 1740. Thus, we are not persuaded as to error in the rejection.

In effect, the panel found that the examiner did not make a prima facie case. A prima facie case is one in which the underlying reason, not just the evidence, exists. Cf. Hyatt v. Dudas, Docket Nos. 2007-1050-1054 (Fed. Cir. 12/24/2008)("Thus, as in McDaniel, the PTO argues that a "ground of rejection" in section 1.192(c)(7) is merely the statutory section under which a group of claims was rejected, rather than the precise reason why the examiner determined that the group of claims failed that statutory requirement. We therefore conclude, as we did in McDaniel, that the PTO's interpretation of section 1.192(c)(7) is plainly erroneous and

inconsistent with the text of the regulation. ... To interpret section 1.192(c)(7) otherwise would allow the Board to subject claims to a new ground of rejection without following the procedures specified in 37 C.F.R. § 41.50(b)"). Also, In re Kronig, 539 F.2d 1300, 1303, 1976 CCPA LEXIS 140; 190 USPQ 425, \_\_\_ (CCPA 1976)("Appellants urge that the ultimate criterion of whether a rejection is considered "new" in a decision by the board is whether appellants have had fair opportunity to react to the thrust of the rejection. We agree with this general proposition, for otherwise appellants could be deprived of the administrative due process rights established by 37 CFR 1.196(b) of the Patent and Trademark Office."). As in Hyatt, the panel here ignored the fact that the examiner's ground for rejection was the specific rationale upon which the examiner relied, not merely a statutory section and cited reference. Accordingly, the panel rejection of the examiner's specific ground for rejection was a rejection of the alleged prima facie case. Accordingly, the panel's affirmance of the rejection instead of entering a new ground of rejection, is improper.

The panel further erred in not defining a prima facie case for rejection of claim 1. What the panel stated is that claim 1 would have been obvious because (1) Stein discloses generating an offline purchase history database and (2) Biorge discloses a portable device which may be used to purchase online. As to motivation to modify in view of Stein and Biorge, the panel concludes that "to create a centralized database which accounts for offline purchases and causes the involved consumer to receive updated advertisements or coupons (FF 3,4) based on all purchases would be a predictable variation to the Biorge system." Where does the offline system obtain correspondence of the portable device of Biorge with the identify of the customer whose offline purchase history is stored by Stein? Lacking that correspondence, how could Stein and Biorge result in claim 1? Claim 1 reads:

Claim 1: A method for delivering a targeted advertisement, comprising:  
receiving from a first computer a first identifier identifying the first  
computer and associated by a purchase behavior classification with an observed  
offline purchase history of a consumer, said purchase history including purchase  
history information of an offline purchase of a consumer collected when the

offline purchase transpired; and

selecting and electronically delivering the targeted advertisement to the consumer at the first computer in response to receiving the first identifier from the first computer, said selecting based on said purchase behavior classification without providing to an advertiser any of said purchase history information, wherein said offline purchase was not transacted with the first computer.

Upon what does the panel's new basis of rejection rely to provide the motivation for the claimed association noted in claim 1?:

receiving from a first computer *a first identifier identifying the first computer* and *associated* by a purchase behavior classification *with an observed offline purchase history* of a consumer

The appellant requests the panel to review and reconsider this issue. Moreover, please note that the appellant argued this point in the brief on page 10, subsection b.

The same issue arises in the analysis of independent claim 55 because of its recitation:

associating said first identifier with said first consumer identification which is associated with said first consumer offline purchase history data

The appellant requests the panel to review and reconsider this issue with respect to claim 55 and the other claims grouped with it, and hence, with all pending claims.

Date: 1-3-2009

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